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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,313	04/08/2008	Jean-Noel Claveau	113035-00137	3807

27557 7590 09/25/2008

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EXAMINER	
AHMED, SHAMIM	
ART UNIT	PAPER NUMBER
1792	
MAIL DATE	DELIVERY MODE
09/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/562,313	CLAVEAU, JEAN-NOEL	
	Examiner	Art Unit	
	Shamim Ahmed	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/8/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 contains the trademark/trade name **Teflon**. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the at least one heat-activated substance and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1,3-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hix et al (4,354,851) in view of Remer (3,565,039) as supported with Echtler (USP 4,283,954).

Hix disclose a process and apparatus for manufacturing a decorating article including the steps of heat transfer printing wherein a decoration or design is printed on a paper transfer sheet with a subliming dye or ink, and there after, the paper is pressed against the textile fabric and heated for a brief period of time and transferred to the textile fabric (article to be decorated) (col.1, lines 35-43 and also see col.2, lines 45-col.3, lines 1-8).

Hix et al teach that the printed transfer sheet contain sublimable coloring agent and the surface coating comprises polymeric coating such as water resistant, clear polymeric coating selected from acrylic polymers, polyester resins, etc. (col.3, lines 9-26).

Unlike the instant invention, Hix et al remain silent the introduction or applying heat by dipping the article to be decorated and the transfer sheet into a bath of non-ferrous metal alloy.

However, Remer teaches an apparatus for coating web or object such as paper, plastics, wires, fibers non-woven fabrics etc. with a suitable ink (col.1, lines 3-18).

Remer also teaches heating is performed to evaporate the solvent by conventional heater element (col.10, lines 33-42) and further teaches hot metal dip drying technique with the advantage of not only drying the webs to effect

solvent removal, but also removing any electrical charges from the webs (col.10, lines 43-47) and typically the hot metal bath includes bismuth, tin, wood's alloy and lead as well as other metals having melting points ranging from 80 to 2000 degree F (col.10, lines 48-61), wherein the wood's alloy contain bismuth, lead, tin and cadmium with the claimed percent of the specific metals as supported by Echtler (see col.3, lines 8-10 in USP 4,283,954).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time of claimed invention to employ Remer's teaching into Hix et al's teaching with the benefit suggested by Remer.

As to claim 15, Hix et al also teach that in addition to the water-resistant coating, the panel may also have one or more substrate coating, which may comprises pigments (col.3, lines 27-33).

As to claim 5, Hix et al's polymeric substrate broadly reads on the claimed Teflon based decorative article.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hix et al in view of Remer (3,565,039) as supported with Echtler as applied to claims 1,3-16 above, and further in view of Briss et al (2002/0104761).

Modified Hix et al discusses above except the alloy including antimony, tin, bismuth and lead.

However, Briss et al teach both the antimony and cadmium are functionally equivalent (see paragraph 0038).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time of claimed invention to modify Remer's alloy by replacing cadmium with

antimony as both the antimony and cadmium are functionally equivalent as suggested by Briss et al.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-4,9,13,16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13,17-20 of copending Application No. 11/792,978. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention in the application Serial No. '978 encompass the instant invention because the heat–activated substance of the instant invention is same as the subliming substance in the co-pending application '978.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/562,332 (US 2008/0011405). Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention in the application Serial No. '332 encompass the instant invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Richer et al (4,997,506) teach conventional process for decorating an article.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shamim Ahmed whose telephone number is (571) 272-1457. The examiner can normally be reached on Tu-Fri (12:30-10:30) Every Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine G. Norton can be reached on (571) 272-1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shamim Ahmed/
Primary Examiner, Art Unit 1792

SA
September 23, 2008